

REMARKS

Claims 46 - 75 are pending in this RCE application. Applicants wish to present certain comments to assist the Examiner in the evaluation of the claims based upon the rejections previously made by the Examiner.

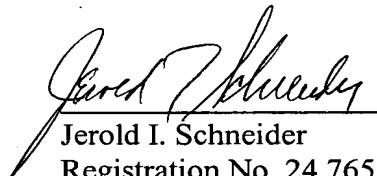
1. The Examiner has previously indicated that certain claimed properties are allegedly inherent since, according to a prior office action, “the same materials and thickness of 4 mm are used”. (Page 4, Official Action mailed October 28, 2002) However, as set forth in the MPEP, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied prior art”. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) See, MPEP 2112. The Examiner has failed to meet these requirements. In particular, the Examiner has failed to establish that any of the above-recited characteristics are necessarily present in the devices described in the references of record. Further, since the rejection is based on a hypothetical “combination” of teachings of the prior art, there is no prior art device upon which the Examiner may rely for a suggestion of the allegedly inherent features. For example, the composition of the glass substrate and/or the coating layer would influence the transmission properties of these layers. Yet the Official Action does not take these into account in the “allegedly inherent” rejection. Similarly, the composition of the glass substrate and/or coating layer would also influence the dominant wavelength in the visible spectrum of the coated versus the uncoated substrate. Yet the Official Action does not take these into account in the “allegedly inherent” rejection.

2. Applicant further wishes to comment further on the propriety or lack of propriety of combining references as has been done to create the rejection. Specifically, there is no teaching or motivation in the references themselves to suggest or support the combination of the Allemand reference with any other reference. The Official Action indicates that both references address glass modifications. It is submitted that such a conclusion begs the question of whether a person of ordinary skill in the art to which the claimed invention pertains, would look at the art of electrochromic devices for any purpose whatsoever. Applicants submit that the Official Action has not established a *prima facie* case that this would be done. The mere fact that patents relate to "glass technology" or modifications of "glass" is not the test. The present record is devoid of any objective evidence that a person of ordinary skill in the art to which the claimed invention pertains would look to the electrochromic device technology.

Reconsideration and allowance of all claims are solicited.

Respectfully submitted,

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